

PATENT
App. Ser. No.: 09/882,917
Atty. Dkt. No. ROC920010074US1
PS Ref. No.: IBM/10074

REMARKS

This is intended as a full and complete response to the Office Action dated August 17, 2006, having a shortened statutory period for response set to expire on November 17, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-26 are pending in the application. Claims 1-26 remain pending following entry of this response. Claim 1 has been amended for clarification. Applicants submit that the amendment does not introduce new matter.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 3, 4, 9, 10, 12, 17, 18, 19, 21 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Plow et al.* (U.S. Pat No. 6,718,518, hereinafter "*Plow*"). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In this case, as described below, *Plow* does not disclose "each and every element as set forth in the claim".

Plow is directed to a non-disruptive search facility. See *Plow*, Title. *Plow* allows a user to search a main application window using a find window which is created based on a user interaction. See *Plow*, Column 3, Lines 58-67. To display the find window, the user activates the "create find window" tool from a drop down edit menu. See *Plow*, Column 4, Lines 55-62. The user can search for a term and view the results in the find window while simultaneously viewing information in the main application window. See *Plow*, Column 3, Lines 58-67.

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With respect to Claim 1, the claim describes "receiving a response containing [an] electronic document comprising [...] at least two frames each containing [...] searchable text". With respect to Claim 10, the claim describes "parsing a response containing an electronic document formatted with at least two frames each containing searchable content". The Examiner states that *Plow* discloses the claimed subject matter. However, the Examiner has not provided a citation to a portion of *Plow* in which the claimed subject matter is disclosed. The Examiner only provides a single citation to a section of *Plow*, and the citation is provided with respect to another claim element. See Office Action dated August 17, 2006 (hereinafter Office Action), Page 3. Furthermore, the portion of *Plow* referenced by the Examiner does not describe receiving a response containing an electronic document. *Plow* does not contain the word "response". See generally, *Plow*. Accordingly, *Plow* does not teach the subject matter asserted by the Examiner. Withdrawal of the rejection is respectfully requested.

With respect to Claims 1, 10, and 21, the claims also describe a document with at least two frames containing searchable content. First, Applicants note that *Plow* does not contain the term "frame". Furthermore, the sole section of *Plow* cited by the Examiner merely describes a find window which is displayed in a main application window. See *Plow*, Column 5, Lines 1-40. A portion of a document containing a search term is displayed in the results area of the find window while the document is displayed in the main application window. See *Plow*, Column 4, Lines 55-67. Accordingly, *Plow* describes two separate windows (the find window and the main application window) which are used to view portions of a single document. See *id.* There is no teaching or suggestion in *Plow* that the document includes at least two frames, nor are frames used to view the document. See *id.* Accordingly, *Plow* does not describe the subject matter asserted by the Examiner. Withdrawal of the rejection is respectfully requested.

With respect to Claim 1, the claim also describes "[a] designated default search frame of the displayed electronic document [which] is available to a user for conducting a search of the searchable text contained in the designated default search frame". The claim also states that "absent a command from the user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically

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initiated in the designated default search frame". Claim 10 describes "automatically designating one of [...] at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames." Claim 21 describes "a default search frame code segment which, when executed by the processor, designates one of the two frames as a default search frame based on a pre-existing specification of the default search frame". With respect to each of the claims, the Examiner's rejection appears to suggest that the find window in *Plow* is a default search frame. However, as described above, *Plow* describes that the find window is activated when a user selects the "create find window" tool from a drop down edit menu. See *Plow*, Column 4, Lines 55-62. Thus, the find window is specifically requested by the user. See *id.* Accordingly, because the find window is explicitly requested by the user to perform a search, the find window is not a default. Therefore, the find window in *Plow* is not a designated default search frame. Accordingly, *Plow* does not describe the claimed subject matter and withdrawal of the rejection is respectfully request.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-8, 10-16, 18-24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cordell* (hereinafter "*Cordell*") US Patent No. 6,031,989 and further in view of *Dauerer et al* (hereinafter *Dauerer*) US Patent No. 6,021,416. Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP

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§ 2143. The present rejection fails to establish at least the third requirement, as described below.

With respect to the third requirement of the prima facie case of obviousness, the references, alone or in combination, must teach or suggest all claim limitations. Claim 1 describes "[a] designated default search frame of the displayed electronic document [which] is available to a user for conducting a search of the searchable text contained in the designated default search frame". The claim also states that "absent a command from the user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame". Claim 10 describes "automatically designating one of [...] at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames." Claim 21 describes "a default search frame code segment which, when executed by the processor, designates one of the two frames as a default search frame based on a pre-existing specification of the default search frame".

The Examiner states that *Cordell* discloses designating one of at least two frames as a default search frame at Figure 5; Column 2, Lines 15-45; Column 3, Lines 1-20; and Column 14, Lines 25-45. Figure 5 of *Cordell* is a block diagram showing frames created with the HTML <FRAMESET> and <FRAME> tags. Column 2, Lines 15-45 of *Cordell* describes "HTML frames [which] allow a number of documents to be displayed side-by-side". Column 3 Lines 1-20 of *Cordell* describes "a method for formatting a HTML document that allows the nesting of other documents within the HTML document is provided." The cited section also describes that "the method is used to specify one or more nested documents (i.e., other electronic documents) which will be displayed within a main document by inserting a new reference tag into a main electronic document (e.g., a HTML document)". See *Cordell*, Column 3 Lines 1-20. Column 14, Lines 25-45 of *Cordell* describes that "[a]n author can nest multiple documents within a main document, and change the layout of the nested documents at any time without significantly affecting the layout and display at the main document." Accordingly, the cited sections merely describe frames and the creation of a nested

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document within a main document. See *Cordell*, Figure 5; Column 2, Lines 15-45; Column 3, Lines 1-20; and Column 14, Lines 25-45. *Cordell* does not describe searching. See generally, *Cordell*. *Cordell* also does not describe designating a frame as a default search frame. See *id.* Accordingly, the cited sections of *Cordell* do not describe the claim limitations asserted by the Examiner. Withdrawal of the rejection is respectfully requested.

With respect to the third requirement of the prima facie case of obviousness, the Examiner also states that *Dauerer* discloses that "the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein absent a command from a user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the default search frame" at Column 5, Lines 35-50. The cited section describes a browser which processes a source file to generate an output display. See *id.* The cited section states that a region within the output display is selected using a pointing device such as a mouse or track ball. See *id.* A client processor identifies a portion of the source file from which the information displayed within the region is generated, and the portion of the source file is output by the client processor. See *id.* Accordingly, the cited section of *Dauerer* merely describes outputting a portion of a source file from which information displayed within a selected region is generated. See *id.* The cited section does not refer to a frame. See *id.* Furthermore, the cited section also does not refer to a search. See *id.* Thus, the cited section does not describe "[a] designated default search frame of the displayed electronic document [which] is available to a user for conducting a search". Accordingly, the cited section of *Dauerer* does not teach or suggest the claim limitation asserted by the Examiner. Because the Examiner has not satisfied the third requirement of the prima facie case of obviousness, withdrawal of the rejection is respectfully requested.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

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Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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